

NEW APPLICATION TRANSMITTAL

Transmitted herewith for filing is the patent application of:

Inventor(s): David L. Brock and Woojin Lee

For (title): SURGICAL INSTRUMENT

J1046 U.S. PTO
09/783637
02/14/01**1. Type of Application**

- ☒ Utility
☐ Design

2. Small Entity

- ☒ Yes
☐ No

3. Benefit of Prior U.S. Application(s) Under 35 U.S.C. §120

This application is a:

- ☐ Divisional
☒ Continuation
☐ Continuing Patent Application (CPA) under 37 C.F.R. §1.53(d)
☐ Continuation-in-part (CIP),

and hereby claims benefit under 35 U.S.C. §120 to the following applications:

SERIAL NUMBER	FILING DATE
PCT/US00/12553	May 9, 2000

4. Benefit of Non-U.S. Application Under 35 U.S.C. §119(a)-(d)

This application claims priority under 35 U.S.C. §119(a)-(d) to the following foreign application(s) and/or inventor certificate(s):

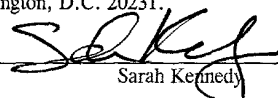
COUNTRY	APPLN. NUMBER	FILING DATE
None		

Certified copy(ies) of the application(s) and/or inventor certificate's from which priority is claimed:

- ☐ is(are) attached;
☐ will follow.

CERTIFICATE OF EXPRESS MAIL UNDER 37 C.F.R. §1.10

I hereby certify that this New Application Transmittal and the documents referred to as enclosed therein are being deposited with the United States Postal Service on 2/14/01 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EL733959219US addressed to the: Assistant Commissioner of Patents, Washington, D.C. 20231.


 Sarah Kennedy

5. **Benefit of Provisional Application Under 35 U.S.C. §119(e)**

This application claims priority to the following provisional application(s):

SERIAL NUMBER	FILING DATE
60/133,407	May 10, 1999

6. **Papers Enclosed Which Are Required For Filing Date Under 37 C.F.R. §1.53**

16 Pages of Specification, including claims and abstract
6 Sheets of Drawing

7. **Additional Papers Enclosed**

- ☐ Declaration and Power of Attorney
☐ Preliminary Amendment
☒ Information Disclosure Statement (37 CFR 1.98), Form PTO-1449 and a copy of each cited reference
☐ Assignment and Form PTO-1595
☐ Declaration of Biological Deposit
☐ Submission of "Sequence Listing" computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequences.
☐ Other _____

8. **Application Filing Fee Calculation**

A. ☒ Utility Application

FEE CALCULATION:

Total Claims: 25 - 20 = 5 × \$18 = \$ 90.00
Independent Claims: 6 - 3 = 3 × \$80 = \$240.00
Basic Fee:\$710.00
Multiple-Dependent-Claim Fee :\$

Total of the Above Calculations: \$1,280.00

- ☐ Amendment canceling extra claims enclosed.
☐ Amendment deleting multiple dependencies enclosed.
☐ Fee for extra claims is not being paid at this time.

B. ☐ Design application - \$320 \$
Application Filing Fee Sub-Total \$
C. ☒ Less 50% reduction for small entity..... \$640.00
D. ☐ Non-English Specification - \$130..... \$

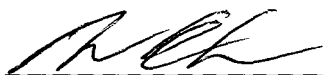
TOTAL FILING FEE \$ 640.00

9. **Payment**

- ☒ Enclosed
- ☒ Check in the amount of the Total Filing Fee set forth above.
- ☐ Charge Account No. 19-0079 in the amount of Total Filing Fee set forth above. A duplicate of this transmittal is attached.
- ☐ Not Enclosed

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 and 1.17 that may be required by this paper or any paper filed in connection with this Patent Application, or refund any overpayment to our Deposit Order Account No. 19-0079.

Respectfully submitted,



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**ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF
PRIOR U.S. APPLICATION(S) CLAIMED**

NOTE: "In order for an application to claim the benefit of a prior filed copending national application, the prior application must name as an inventor at least one inventor named in the later filed application and disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C. 112." 37 CFR 1.78(a).

NOTE: "In addition the prior application must be (1) complete as set forth in ' 1.51, or (2) entitled to a filing date as set forth in ' 1.53(b) and include the basic filing fee set forth in ' 1.16; or (3) entitled to a filing date as set forth in ' 1.53(b) and have paid therein the processing and retention fee set forth in ' 1.21(1) within the time period set forth in ' 1.53(d)." 37 CFR 1.78(a).

9. Relate Back--35 U.S.C. 120

NOTE: "Any application claiming the benefit of a prior filed copending national or international application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior application identifying it by serial number and filing date or international application number and international filing date and indicating the relationship of the applications." 37 CFR 1.78(a). See also the Notice of April 28, 1987 (1079 O.G. 32 to 46).

 X Amend the Specification by inserting before the first line the sentence:

"This is a

 X continuation
 — continuation-in-part
 — divisional

of copending application(s)

 — serial number 0 — / — filed on — "

 X International Application PCT/US00/12553 filed on May 9, 2000 and which designated the U.S. "

NOTE: The proper reference to a prior filed PCT application which entered the U.S. national phase is the U.S. serial number and the filing date of the PCT application which designated the U.S.

NOTE: (1) Where the application being transmitted adds subject matter to the International Application then the filing can be as a continuation-in-part or (2) it is desired to do so for other reasons, e.g. where no declaration is available, no English translation is available or no fee is to be paid on filing then the filing can be as a continuation. In these cases the International Application designating the U.S. is treated as the parent case in the U.S. and is an alternative to the completion of the International Application under 35 U.S.C. 371(c)(4) which must meet the requirements of 37 CFR 1.61(a). This alternative permits the completion of the filing requirements within any term set by the PTO under 37 CFR 1.53(d) to which the extension provisions of 37 CFR 1.136(a) apply. (Whereas, if the filing is as an international application entering the U.S. stage then the fee, declaration and/or English translation (where necessary) is due within 20 months of the priority date but can be paid within 22 months of the priority date (or is due within 30 months of the priority date but can be submitted within 32 months of the priority date) with the surcharges set forth in 37 CFR 1.492(e), (f) and 37 CFR 1.495(c); however, the provisions of 37 CFR 1.136 do not apply to this 22 or (32 month) period. 37 CFR 1.61(b).)

NOTE: The deadline for entering the national phase in the U.S. for an international application was clarified in the Notice of April 28, 1987 (1079 O.G. 32 to 46) as follows:

"The Patent and Trademark Office considers the International application to be pending until the 22nd month from the priority date if the United States has been designated and no Demand for International Preliminary Examination has been filed prior to the expiration of the 19th month from the priority date and until the 32nd month from the priority date if a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of the 19th month from the priority date, provided that a copy of the international application has been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively. If a copy of the international application has not been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively, the international application becomes abandoned as to the United States 20 or 30 months from the priority date respectively. These periods have been placed in the rules as paragraph (h) of ' 1.494 and paragraph (i) of ' 1.495. A continuing application under 35 U.S.C. 365(c) and 120 may be filed anytime during the pendency of the international application. "

10. **Relate Back--35 U.S.C. 119 Priority Claim for Prior Application**

The prior U.S. application(s), including any prior International Application designating the U.S., identified above in item 17, in turn itself claim(s) foreign priority (ies) as follows:

United States	60/133,407	May 10, 1999
country	appln. no.	filed on

The certified copy (ies) has (have)

— been filed on _____ in prior application 0_ / _____ filed on
which was filed on _____.

— is (are) attached

WARNING:

The certified copy of the priority application which may have been communicated to the PTO by the International Bureau may **not** be relied on without any need to file a certified copy of the priority application in the **continuing application**. This is so because the certified copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S. serial number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore such certified copies may not be available if needed later in the prosecution of a continuing application. An alternative would be to physically remove the priority documents from the folders and transfer them to the continuing application. The resources required to request transfer, retrieve the folders, make suitable record notations, transfer the certified copies, enter and make a record of such copies in the Continuing Application are substantial. Accordingly, the priority documents in folders of international applications which have not entered the national stage may not be relied on. Notice of April 28, 1987 (1079 O.G. 32 to 46).

11. **Maintenance of Copendency of Prior Application**

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of November 5, 1985(1060 O.G. 27).

A. — Extension of time in prior application

(This item must be completed and the papers filed in the prior application if the period set in the prior application has run)

— A petition, fee and response extends the term in the pending prior application until

— A copy of the petition filed in prior application is attached

B. — Conditional Petition for Extension of Time in Prior Application

(complete this item if previous item not applicable)

— A conditional petition for extension of time is being filed in the pending prior application.

— A copy of the conditional petition filed in the prior application is attached

12. Further Inventorship Statement Where Benefit of Prior Application(s) Claimed

NOTE: "If the continuation, continuation-in-part, or divisional application is filed by less than all the inventors named in the prior application a statement **must** accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation, continuation-in-part, or divisional application." 37 CFR 1.62(a) [emphasis added]. (dealing with the file wrapper continuation situation).

NOTE: "In the case of a continuation-in-part application which adds and claims additional disclosure by amendment, an oath or declaration as required by ' 1.63 must be filed. In those situations where a new oath or declaration is required due to additional subject matter being claimed, additional inventors may be named in the continuing application. In a continuation or divisional application which discloses and claims only subject matter disclosed in a prior application, no additional oath or declaration is required and the application must name as inventors the same or less than all the inventors in the prior application." 37 CFR 1.60(c). (dealing with the continuation situation).

(complete applicable item (a), (b) and/or (c) below)

- (a) X This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are

 X the same

 less than those named in the prior application and it is requested that the following inventor(s) identified for the prior application be deleted:

(Type name(s) of inventor(s) to be deleted)

- (b) This application discloses and claims additional disclosure by amendment and a new declaration or oath is being filed. With respect to the prior application the inventor(s) in this application are

 the same

 the following additional inventor(s) have been added

(Type name(s) of inventor(s) to be added)

- (c) The inventorship for all the claims in this application are

 X the same

 not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made

 is submitted

 will be submitted

13. Abandonment of Prior Application (if applicable)

 Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application copending with said prior application.

NOTE: According to the Notice of May 13, 1983 (103, TMOG 6-7) the filing of a continuation or continuation-in-part application is a proper response with respect to a petition for extension of time or a petition to revive and should include the express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

FORM 636-60

14. Petition for Suspension of Prosecution for the Time Necessary to File an Amendment

WARNING: "The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all the claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds of art of record in the next Office action if they had been entered in the earlier application." MPEP, ' 706.07(b).

NOTE: Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary.

(check the next item, if applicable)

☐ There is provided herewith a Petition To Suspend Prosecution for the Time Necessary to File An Amendment (New Application Filed Concurrently)

15. NOTIFICATION IN PARENT APPLICATION OF THIS FILING

☐ A notification of the filing of this

(check one of the following)

☐ continuation

☐ continuation-in-part

☐ divisional

is being filed in the parent application from which this application claims priority under 35 USC 120.

FOR FILING